

### **REMARKS/ARGUMENTS**

Applicants have carefully considered the Office Action mailed May 17, 2007, and respectfully requests reconsideration in view of the following remarks.

Applicants hereby request acknowledgement of the Information Disclosure Statements filed July 9, 2004. A copy of the IDS filed July 9, 2004 is included for convenience.

#### **The 35 U.S.C. § 103 Rejection**

Claims 19-25 and 27-33 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over McIntosh (US 5,103,404) in view of Applicants' Admitted Prior Art (AAPA), among which claims 19, 25, and 31 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>1</sup>

When a rejection is based on a combination of prior art sources, the examiner must identify the “reason to combine the known elements in the fashion claimed by the patent at issue,” and “this analysis should be made explicit.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). An obviousness rejection “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Specifically, the Office Action contends that the elements of the claimed subject matter are disclosed in *McIntosh* except that *McIntosh* “does not disclose wherein the haptic feedback including a modulating force simulating a plurality of electronically defined stop positions.”<sup>2</sup>

The Office Action further contends that the AAPA on page 2, line 17 to page 3, line 5 teaches

where it is well known in the art where haptic feedback devices have control wheel that exhibit tactile responsiveness, such as detents or clicks as they are rotated, wherein each click is a modulating force simulating a plurality of electronically defined stop positions, such that each click corresponds to one frame,

and that it would be obvious to one having ordinary skill in the art to incorporate “the modulating force simulating a plurality of electronically defined stop positions as taught by AAPA,” in order to “enable the user to determine frame rates as discussed on pages 2 and 3 of applicant’s specification.” The Applicants respectfully disagree for the reasons set forth below.

Applicants note in two separate places on pages 2 and 3 of the Office Action, the Examiner states that *McIntosh* teaches “the haptic feedback including a modulating force simulating a plurality of electronically defined stop positions (col. 2, lines 49–54, col. 3, lines 1–30).” These statements contradict the Examiner’s later statement that *McIntosh* does *not* include this limitation, and Applicants respectfully suggest the former statements are an error.

Applicants agree with the Examiner’s later statement on page 3 that this element is *not* found within *McIntosh*, because the cited portion of *McIntosh* makes no reference to a simulated plurality of electronically defined stop positions.

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<sup>1</sup> M.P.E.P § 2143.

<sup>2</sup> Office Action p. 3.

As to the Examiner's statement that the provision of torque data "based on a selection of at least one force profile from a plurality of force profiles" is found in *McIntosh* at "col. 10, lines 24–25,"<sup>3</sup> Applicants disagree, noting that the two lines the Examiner cites within the *McIntosh* specification make no reference to a force profile or a plurality of force profiles. Nor is this limitation found in column 3, lines 1–30, which does not refer to a "selection of at least one force profile from a plurality of force profiles."

The section of Applicants' specification identified by the Examiner as the AAPA (page 2, line 17 to page 3, line 3) discusses the prior art film editing system shown in Figures 1 and 1a, which has a control wheel producing "clicks" as the wheel is rotated, created by a "mechanical detent mechanism" in which a "sprocket" has "a fixed number of cogs or detents corresponding to the desired number of clicks per revolution."<sup>4</sup> Independent claims 19, 25, and 31, however, include the limitation of "*simulating a plurality of electronically defined stop positions*," a function that the prior art mechanical system of cogs or detents described in the AAPA does not perform.

Furthermore, one of ordinary skill in the art of video editing systems would not have the skill or the insight required to modify the teachings of *McIntosh* and/or the AAPA to include a haptic system capable of simulating a plurality of electronically defined stop positions. The combination *McIntosh* and the AAPA, together with "haptic feedback including a modulating force simulating a plurality of electronically defined stop positions" would not have been predictable prior to the present application, and the Examiner has articulated no "reasoning with some rational underpinning to support the legal conclusion" that such an addition would be obvious. *KSR*, 127 S. Ct. at 1741.

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<sup>3</sup> Office Action p. 2.

<sup>4</sup> Specification, p. 3, ll. 22–26.

As to dependent claims 20–24, 27–30, and 32–33, the arguments set forth above are equally applicable here. The base claims being allowable, the dependent claims must also be allowable. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

Conclusion


It is believed that the claims are in condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,  
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Dated: August 17, 2007

  
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